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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

NGUYEN, TRI V

ART UNIT	PAPER NUMBER
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1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/839,138	Applicant(s) HIRAGA, MASAKI	
	Examiner Tri V. Nguyen	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In the amendment file on November 30, 2006, Claims 1-6, 8-20 and 22 have been amended and Claim 21 has been cancelled. The currently pending claims considered below are Claims 1-20 and 22.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the user's terminal" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the any of the keywords" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Ng (US 6,405,175).

Claim 22: Ng discloses a method for providing points based on a retrieval of keywords, comprising:

- a. providing information to a first user responsive to selection of keywords (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords); and
- b. assigning at least one point to a second user in response to any of the keywords being selected and registered, by the second user, from a keywords previously presented to the second user and associated with the provided information (col 8, lines 33-49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 8, 9, 12-14, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,405,175) in view of Rothstein (US 2002/0188532).

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Claim 1: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. presenting keywords to a first user through a network, and storing keywords selected from the presented keywords by the first user into a user-by-keyword management table relating to the user (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords);
- b. presenting keywords to an advertiser through the network, and storing keywords selected by the advertiser into an advertiser-by-keyword management table relating to the advertiser;
- c. searching the user-by-keyword management table and the advertiser-by-keyword management table for keywords when there has been a request for retrieving the keywords from a second user different from the first user through the network, and when the requested keywords have been registered both in the user-by-keyword management table and the advertiser-by-keyword management table, posting a retrieved result of the keywords and advertisement of the corresponding advertiser to the second user through the network (col 8, lines 33-49); and
- d. giving points to the first user when the second user has referred to the advertisement, and storing these points into a user's-point management table relating to the first user (col 8, lines 33-49).

Ng does not explicitly disclose step b. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60). In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 25-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

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the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchase the items advertised.

Claim 2: Ng and Rothstein disclose the method of providing points according to the claim 1, wherein the points gained by the first user are exchanged for a product or a service (Ng: col 9, lines 23-29).

Claim 3: Ng and Rothstein disclose the method of providing points according to the claim 1, wherein the points comprise user points that are generated when the second user has retrieved the user-obtained keywords and advertiser points that are generated when the second user has referred to the advertisement (Ng: col 5, lines 4-9).

Claim 8: Ng and Rothstein disclose the method of providing points according to the claim 1, but do not explicitly disclose wherein the first user who has registered the keywords can select a display on the Web or a transmission by e-mail as a method of presenting the advertisement to the other users. Rothstein discloses the use of either email or web page as a display means (page 2, parag 25-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Rothstein, with displaying the advertisement via an email or a web page since it was known in the art that different display channels are used to enhance the ways to reach the users.

Claim 9: Ng and Rothstein disclose a method of providing points comprising:

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- a. obtaining keywords that a first user can obtain from a server through a network, and displaying the obtained keywords at the first user's terminal (col 5, line 21 to col 6, line 51);
- b. transmitting keywords that the first user has selected from the displayed keywords the first user's terminal to the server (col 5, line 21 to col 6, line 51);
- c. presenting results of retrieval by other user together with advertisement of advertisers corresponding to the keywords registered in the server to the other user, when the other user different from the first user has retrieved the keywords through the network; and
- d. giving points to the first user who has obtained the keywords, when the other user has referred to the advertisement (col 8, lines 33-49).

Ng does not explicitly disclose step c. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60). In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchase the items advertised.

Claims 12 and 13 disclose the apparatus and the computer readable medium of the method Claim 1 respectively. The prior art of et al. as set forth above in Claim 1 is relied upon to reject Claims 12 and 13.

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Claims 14 and 18 disclose the computer readable medium and the program of the method Claim 9 respectively. The prior art of et al. as set forth above in Claim 9 is relied upon to reject Claims 14 and 18.

Claim 17: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. presenting keywords to a first user through a network, and storing keywords selected from the presented keywords by the first user into a user-by-keyword management table relating to the user (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords);
- b. presenting keywords to an advertiser through the network, and storing keywords selected by the advertiser into an advertiser-by-keyword management table relating to the advertiser;
- c. searching the user-by-keyword management table and the advertiser-by-keyword management table for keywords when there has been a request for retrieving one or more of the keywords from a second user different from the first user through the network, and when any of the requested keywords have been registered both in the user-by-keyword management table and the advertiser-by-keyword management table, posting a retrieved result of the keywords and advertisement of the corresponding advertiser to the second user through the network (col 8, lines 33-49); and
- d. giving points to the first user when the advertisement is presented to the second user, and storing these points into a user's-point management table relating to the first user (col 8, lines 33-49).

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Ng does not explicitly disclose step b. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60). In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 25-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchase the items advertised.

Claim 18: Ng and Rothstein disclose a method of providing points based on a retrieval of keywords, the method comprising:

- a. obtaining keywords that a first user can obtain from a server through a network, and displaying the obtained keywords at the first user's terminal (col 5, line 21 to col 6, line 51);
- b. transmitting keywords that the first user has selected from the displayed keywords at the first user's terminal to the server (col 5, line 21 to col 6, line 51);
- c. presenting results of retrieval by second user together with an advertisement of advertisers corresponding to any of the keywords registered in the server to the first user, when the second user different from the first user has retrieved the keywords through the network; and
- d. giving points to the first user who has obtained the keywords, when the advertisement is presented to the second user (col 8, lines 33-49).

Ng does not explicitly disclose step c. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60).

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In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchase the items advertised.

6. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng and Rothstein as applied to claim 1 above, and further in view of Marks et al. (US 2001/0051911).

Claims 4-7: Ng and Rothstein disclose the method of providing points according to the claim 1, but do not explicitly disclose the various ways of charging for the keywords. Ng recites the use of heuristic rules to improve the obtained results (col 11, lines 43-60). Rothstein discloses an accounting manager to maintain the records of the transactions and the compensation information (page 2, parag. 25 and 35). In an analogous art, Marks et al. recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). Furthermore, the fee structure is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Rothstein to include a fee structure for charging the keywords. One would have been motivated to implement a payment scheme in order to attract advertisers by giving the advertisers a decision choice depending on the revenue, viewing experience and traffic stream pattern.

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7. Claims 10, 11, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothstein (US 2002/0188532) in view of Ng (US 6,405,175).

Claim 10: Rothstein discloses a method of providing points comprising:

- a. obtaining keywords that an advertiser can obtain from a server through a network, and displaying the obtained keywords at advertiser's terminal (page 2, parag. 25-37);
- b. transmitting keywords that the advertiser has selected from the advertiser's terminal to the server (page 2, parag. 25-37);
- c. presenting results of retrieval of keywords by a first user together with an advertisement of the advertiser to the first user, when the first user has retrieved the keywords (page 2, parag. 25-37); and
- d. giving points to a second user who has obtained the retrieved keywords stored in the server from the keywords previously presented to the second user, when the first user who has retrieved the keywords has referred to the advertisement.

Rothstein does not explicitly disclose step d. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised.

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Claim 11: Rothstein discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. displaying retrieved results of keywords together with advertisement of advertiser corresponding to the keywords at a first user's terminal, when the first user has retrieved the keywords from the user's terminal through a network (page 2, parag. 25-37); and
- b. giving points to a second user who has selected the keywords from the keywords previously presented to the second user, when the first user has referred to the displayed advertisement.

Rothstein does not explicitly disclose step b. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised.

Claim 15 discloses the computer readable medium of the method Claim 10. The prior art of Rothstein and Ng as set forth above in Claim 10 is relied upon to reject Claim 15.

Claim 16 discloses the computer readable medium of the method Claim 11. The prior art of Rothstein and Ng as set forth above in Claim 11 is relied upon to reject Claim 16.

Claim 19: Rothstein discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. obtaining keywords that an advertiser can obtain from a server through a network, and displaying the obtained keywords at advertiser's terminal (page 2, parag. 25-37);
- b. transmitting keywords that the advertiser has selected from the advertiser's terminal to the server (page 2, parag. 25-37);
- c. presenting results of retrieval of keywords by a first user together with an advertisement of the advertiser to the first user, when the first user has retrieved the keywords (page 2, parag. 25-37); and
- d. giving points to a second user who has registered any of the retrieved keywords stored in the server from the keywords previously presented to the second user, when the advertisement is presented to the first.

Rothstein does not explicitly disclose step d. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised.

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Claim 20: Rothstein discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. displaying retrieved results of keywords together with advertisement of advertiser corresponding to the keywords at a first user's terminal, when the first user has retrieved the keywords from the first user's terminal through a network (page 2, parag. 25-37); and
- b. giving points to a second user who has registered any of the keywords from the keywords previously presented to the second user, when the displayed advertisement is presented to the first user.

Rothstein does not explicitly disclose step b. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised.

Response to Arguments

8. Applicant's arguments filed on November 30, 2006 have been fully considered but they are not persuasive.

- a. Regarding claims 1-20 and 22, applicants argue that the prior art does not teach the feature of "presenting keywords to the first user" (page 10 et seq.). The examiner

respectfully disagrees as the Ng reference clearly shows that the product/services reviews (which are considered as the applicants' keywords) are presented to the user for further review and that the user is rewarded in proportion to the volume of users that use the updated information (col 5, line 4 to col 6, line19). Thus, the reviewer that logs into the website is presented with keywords, once the user select the review and correct the review, the selected review is related to the user so that the user can receive potential rewards. Furthermore, the category available to the initial review process is also considered as a keyword that is presented to the user. For example in Figure 3, Ng discloses category and subcategory options that are presented to the user.

b. Regarding claim 1, applicants further argue that examiner utilized "improper motivation" to recreate the applicant's invention, as "there must be some logical reason apparent from the positive, concrete record which justifies a combination of primary and secondary references." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397, 1398 (Fed. Cir. 1985). The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, the examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in *In re Sheckler*, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures

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taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). The examiner respectfully asserts that it would be obvious to a skilled artisan in the marketing art to combine the Ng and Rothstein references as Ng teaches a keywords selection process that includes targeted advertisement presentation while the Rothstein reference teaches the feature of advertisement being associated with keywords.

c.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

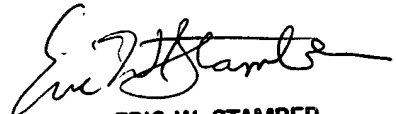
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NVT
February 16, 2007



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600